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10/525,664	02/25/2005	Makio Yamaki	450100-05126	7984

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EXAMINER	
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ART UNIT	PAPER NUMBER
2169	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/525,664	YAMAKI, MAKIO	
	Examiner	Art Unit	
	KUEN S. LU	2169	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 February 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☒ Claim(s) *1-5* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *25 February 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *2/25/05,1/14/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. The Action is responsive to Applicant's Application filed February 25, 2005.

2. Please note claims 1-7 are pending.

Drawings

3. The drawings, filed February 25, 2005, are considered in compliance with 37 CFR 1.81 and accepted.

Priority

4. Applicant's claim of foreign priority on Japan application 2003-188958 filed June 30, 2003, under 35 U.S.C. 119(a)-(d) or (f) is acknowledged.

Information Disclosure Statement

5. The information disclosure statements (IDS) submitted on February 25, 2005 and January 14, 2008 were filed before the mailing of a first Office action after the filing of the application. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Specification

6.1. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

6.2. The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:
(1) if a machine or apparatus, its organization and operation;
(2) if an article, its method of making;
(3) if a chemical compound, its identity and use;
(4) if a mixture, its ingredients;
(5) if a process, the steps.

6.3. Extensive mechanical and design details of apparatus should not be given.

Applicant is reminded of the proper language and format for an abstract of the

disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

6.4. The Abstract is objected to because it contains word “invention” and phrase

“according to this invention” in which “invention” can be implied. Correction is required.

6.5. The Specification is objected to because the section title of CROSS

REFERENCE TO RELATED APPLICATION is not included for describing foreign

priority and incorporated cross reference. Correction is required.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7.1. Claim **7** is rejected under 35 U.S.C. 101 because the claimed invention is directed

to non-statutory subject matter.

As per claim 7, the claim represents a temporary management program causing a computer to perform association steps. The program is clearly not machine or an article of manufacture having physical supporting structure, are not a series of steps or acts to be a process, and nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se.*

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994).

Merely claiming non-functional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer").

7.2. Examiner respectfully acknowledges that claims 1-6 are of statutory, under 35 U.S.C. 101.

As per claim 1, the claim describes a temporary storage management apparatus comprising of association means and association changing means, based on specification, which are CPU and are of physical structure. Therefore, claim 1 and dependents (claims 2-5) are of statutory category machine.

As per claim 6, the method claim perform association steps in which the steps tie to recording medium which belongs to statutory of manufacture category and the steps further transform its underlying subject matter, such as an article or manufacture, to a different state or thing. Therefore the claim is of statutory category of process.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8.1. Claims 1-2 and 5-7 are rejected under 35 U.S.C. 102(b) as anticipated by **Hori** et al.: "SPECCIAL REPRODUCTION CONTROL INFORMATION DESCRIBING METHOD, SPECIAL REPRODUCTION CONTROL INFORMATION CREATING APPARATUS AND METHOD THEREFOR, AND VIDEO REPRODUCTION APPARATUS AND METHOD THEREFOR", U.S. Patent Application Publication **2003/0086692 A1**, filed December 16, 2002 and published My 8, 2003, hereafter "**Hori**".

As per claim 1, Hori teaches "A temporary storage management apparatus for managing temporary storage of content data allowed to be temporarily stored in a recording medium so as to be reproducible only within a prescribed temporary storage allowable time" (See Fig. 6 and [0136] where video data and special reproduction control information are stored to contents storage unit), said temporary storage management apparatus comprising:

"association means for associating a first temporary storage start time out of temporary storage start times of prescribed parts of the content data with a reproducible start point indicating a start point from which the content data can be reproduced" (See Figs. 26-29, 49 and [0231]-[0232] where display time D'i is related with i-th frame content information which is associated with the reproduction time in the special reproduction control information and the i-th frame content is displayed when the display time is larger than a threshold display value in which the content is temporarily stored when the content is being displayed); and

"association changing means for re-associating another temporary storage start time following the temporary storage start time with the reproducible start point every time when a period from the temporary storage start time associated with the reproducible start point to a current time reaches the temporary storage allowable time" (See Figs. 26-29, 49 and [0231]-[0233] where display time D'i is related with i-th frame content information which is associated with the reproduction time in the special reproduction control information and the i-th frame content is not displayed when the display time is

not larger than a threshold display value, and the display time is added to the added display time of the i-th frame in which the a content is temporarily stored when the content is being displayed).

As per claim 6, the claim is directed to the document management method of claim 1 and therefore rejected along the same rationale.

As per claim 7, the claim is directed to the computer program product for functions of claim 1 and therefore rejected along the same rationale.

As per claim 2, Hori teaches "The temporary storage management apparatus according to claim I, further comprising a volatile memory for storing information of the temporary storage start time associated with the reproducible start time" (See Fig. 3 and [0126]-[0127] where storage units may be optical or semiconductor memory for storing special reproduction control information).

As per claim 5, Hori teaches "The temporary storage management apparatus according to claim 1, further comprising start time extraction means for sequentially extracting the temporary storage start time added to an inter frame encoded image, from the content data comprising video data created by sequentially compressing and encoding the prescribed parts each having a plurality of frame images with a beginning

as the inter frame encoded image" (See Hori: [0391] where image data is extracted and displayed and further [0186] where frame is extracted one after another).

Claim Rejections - 35 USC § 103

9.1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9.2. Claim 3 is rejected are rejected under U.S.C. 103(a) as being unpatentable over **Hori** et al.: "SPECCIAL REPRODUCTION CONTROL INFORMATION DESCRIBING METHOD, SPECIAL REPRODUCTION CONTROL INFORMATION CREATING APPARATUS AND METHOD THEREFOR, AND VIDEO REPRODUCTION APPARATUS AND METHOD THEREFOR", U.S. Patent Application Publication **2003/0086692 A1**, filed December 16, 2002 and published My 8, 2003, hereafter "**Hori**"; and in view of **Safadi et al.**: "PERSONAL VERSATILE RECORDER: ENHANCED FEATURES, AND METHODS FOR ITS USE", U.S. Patent Application Publication **2002/0009285 A1**, filed August 17, 2001 and published January 24, 2002, hereafter "**Safadi**".

As per claim 3, Hori teaches temporary storage management with respect to temporarily storage time as described previously.

Hori does not explicitly teach "The temporary storage management apparatus according to claim 2, wherein said volatile memory stores encrypted key data used for encryption of the content data temporarily stored in said recording medium after being encrypted".

However, Safadi teaches encrypting or re-encrypting content and then storing the encrypted or re-encrypted content to a storage device, such as personal versatile recorder disk (See [0090]).

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine the teaching of Safadi with Hori reference because the combined teaching would have enhanced data security with respect to viewing and pay-per-viewing media content.

9.3. Claim 4 is rejected are rejected under U.S.C. 103(a) as being unpatentable over **Hori** et al.: "SPECCIAL REPRODUCTION CONTROL INFORMATION DESCRIBING METHOD, SPECIAL REPRODUCTION CONTROL INFORMATION CREATING APPARATUS AND METHOD THEREFOR, AND VIDEO REPRODUCTION APPARATUS AND METHOD THEREFOR", U.S. Patent Application Publication **2003/0086692 A1**, filed December 16, 2002 and published My 8, 2003, hereafter "**Hori**"; and in view of **Kaneko et al.**: "CONTENT DOWNLOAD SYSTEM", U.S. Patent Application Publication **2002/0077899 A1**, filed February 26, 2001 and published June

20, 2002, hereafter "**Kaneko**".

As per claim 4, Hori teaches temporary storage management with respect to temporarily storage time as described previously and further teaches "information recording means for, when copy allowed content data allowing copy without restrictions or copy one generation is recorded with the content data which is allowed to be temporarily stored" (See [0112] and [0155] where content reproduction is performed with combination of reproduction options and further at Fig. 3 and [0126]-[0127] where storage units may be optical or semiconductor memory for storing special reproduction control information)

Hori does not explicitly teach "recording history information of temporary storage of the content data and recording of the copy allowed content data in said recording medium".

However, Kaneko teaches using storage device to store history data of user operation or the like (See [0073]).

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine the teaching of Kaneko with Hori reference because the combined teaching would have allowed content downloading being more flexible and specific customized to user's desire for obtaining main content and advertisement information.

The combined teaching of Kaneko and Hori further teaches the following:

"determination means for, when a reproduction disabling detection time which is the temporary storage allowable time before the current time almost matches the temporary storage start time associated with the reproducible start point, determining based on the history information whether the content data was temporarily stored at the reproduction disabling detection time" (See Hori: Figs. 26-29, 49 and [0231]-[0233] where display time D'i is related with i-th frame content information which is associated with the reproduction time in the special reproduction control information and the i-th frame content is not displayed when the display time is not larger than a threshold display value, and the display time is added to the added display time of the i-th frame in which the a content is temporarily stored when the content is being displayed, and Kaneko: [0073] using storage device to store history data of user operation or the like), and "wherein said reproducible range updating means changes the temporary storage start time to be associated with the reproducible start point, depending on a determination result of the determination means, only when the content data was temporarily stored at the reproduction disabling detection time" (See Hori: Figs. 26-29, 49 and [0231]-[0232] where display time D'i is related with i-th frame content information which is associated with the reproduction time in the special reproduction control information and the i-th frame content is displayed when the display time is larger than a threshold display value in which the content is temporarily stored when the content is being displayed, and further at Fig. 3 and [0126]-[0127] where storage units may be optical or semiconductor memory for storing special reproduction control information).

References

10.1. The prior art made of record

A. U.S. Patent Application 2003/0086692

B. U.S. Patent Application 2002/0009285

C. U.S. Patent Application 2002/0077899

10.2. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

D. U.S. Patent Number 6,396,508

Contact Information

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to KUEN S. LU whose telephone number is (571)-272-4114. The examiner can normally be reached on Monday-Friday (8:00 am-5:00 pm). If attempts to reach the examiner by telephone pre unsuccessful, the examiner's Supervisor, Pierre Vital can be reached on (571)-272-4215. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for Page 13 Published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should You have questions on access to the Private PAIR system; contact the Electronic Business Center (EBC) at 866-217-9197 (toll free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information system, please call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KUEN S. LU /Kuen S Lu/ Art Unit 2169

Primary Patent Examiner February 3, 2009